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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,850	03/26/2004	Jose Merino Lopez	033818-103	8135
21839	7590	05/15/2006	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			MAKI, STEVEN D	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/809,850	<b>Applicant(s)</b> LOPEZ, JOSE MERINO	
	<b>Examiner</b> Steven D. Maki	<b>Art Unit</b> 1733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) **Claims 1, 3-8, 10-13 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lopez (WO 01/60641).**

WO 01/60641 to Lopez is available as prior art under 102(b) since its publication date (8-23-01) is more than one year before the filing date (9-20-02) of applicant's parent application PCT/EP02/10560. See MPEP 201.13. US 6,874,552, which is not available as prior art under 35 USC 102, is an English language equivalent to WO 01/60641.

Lopez discloses a tire having a tread comprising blocks wherein at least one block is provided with at least one first incision and at least one second incision. In the embodiment of figure 6, the first incision 64 opens to the running surface of the tread when new. The first incision 64 also opens to both lateral faces of the block. The second incisions 65, 66 are spaced from the running surface of the tread when new and are spaced from the first incision and each other. Since the second incisions are

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separated from the running surface, the second incisions define "holes" as claimed. In the embodiment of figure 10, the block comprises two first incisions 82, 83 and four second incisions 84-86 wherein incisions 85 and 86 are located between the first incisions. Lopez teaches that a "large number of second incisions", which are active only once minimum wear of the block 80 has occurred permits an increase in the flexibility of the block. Lopez is silent as to the second incisions 84-86 opening to both lateral faces. However, Lopez teaches, as variants, opening the first incisions on to two lateral faces and opening second incisions on to the lateral faces to permit evacuation of air and reduce traveling noise.

Claim 1 is anticipated by the tread disclosed by Lopez. It is noted that second incisions 85, 86 ("holes") are on one and the same side of the first incision 82 ("incision") and are on one and the same side of first incision 83 ("incision"). It is also noted that Lopez expressly teaches that the second incisions ("holes") may open to both lateral faces of the block. Lopez therefore describes the claimed tread with sufficient specificity to anticipate claim 1. In any event: It would have been obvious to one of ordinary skill in the art to provide a block of Lopez's tread with at least one first incision ("incision") intersecting the running surface and at least two second incisions ("holes") wherein opposite ends of each second incision ("hole") open onto respective lateral faces of the block and all second incisions ("holes") are spaced from the at least one first incision ("incision") since (1) Lopez teaches providing at least one block with **at least one first incision ("incision")** opening onto the running surface of the tread when new and **at least one second incision ("hole")** spaced from the running surface

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of the tread when new, (2) Lopez teaches using a large number of second incisions ("holes") which are spaced from the first incision(s) and are spaced from each other, and (3) Lopez teaches that the second incisions (holes) may open onto the lateral faces of the block.

As to claims 3 and 12, Lopez shows second incisions 84-87 (holes) as being "distributed over the height of the incision" / "over a height at least equal to the depth of the at least one incision".

As to claim 4, Lopez teaches arranging first incisions 82, 83 (incisions) along two different and parallel planes.

As to claim 5, Lopez teaches orienting second incisions 85, 86 (holes) in the transverse direction. See for example figures 6, 10 and 12.

As to claim 6, Lopez shows symmetric second incisions (holes) as an alternative to asymmetric second incisions (holes). Also, note dimensions for P1m, P1M, P2m, P2M.

As to claim 7, Lopez teaches orienting the first incisions 82, 83 (incisions) in the transverse direction. See for example figures 6, 10 and 12.

Claims 8 and 10 are not anticipated by Lopez. However, it would have been obvious to one of ordinary skill in the art to provide the second incisions (holes) with a sectional area of  $0.75$  to  $5 \text{ mm}^2$  / the second incisions (holes) with a volume greater than 20% of the block in view of (1) Lopez's teaching to provide each second incision with a low width of for example less than 1.5 mm at the depths of P2M, P2m / (2)

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Lopez's teaching to use a large number of second incisions (holes) to increase flexibility of the block after wear with a significant increase in grip.

As to claim 11, Lopez teaches that the first incisions (incisions) may be undulating.

As to claim 13, Lopez teaches locating two second incisions (holes) between first incisions (incisions) 82 and 83. See figure 10.

As to claim 15, Lopez teaches orienting first incisions 82, 83 (incisions) and second incisions 85, 86 (holes) in the transverse direction.

**4) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez (WO 01/60641) as applied above and in view of Lagnier (US 5,783,002).**

Lopez is considered to anticipate claim 11. In any event: As to claim 11, it would have been obvious to provide Lopez's first incisions such that they are self locking as claimed in view of Lagnier's suggestion to provides sipes (incisions) with projections and recesses in the depth direction of the tread to improve adherence to icy pavement and reduce irregular wear.

**5) Claims 3, 6, 8, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez (WO 01/60641) as applied above and in view of Europe 709 (EP 1125709).**

As to claims 8 and 9, it would have been obvious to provide Lopez's blocks with circular holes having a diameter of 1-2.5 mm<sup>2</sup> / sectional area of 0.75 to 5 mm<sup>2</sup> since Europe 709, which also teaches hidden incisions (incisions spaced from the running surface), suggests forming circular holes in the block at the leading edge side of a block

to lower rigidity and reduce striking sound when the leading edge of the block contacts the ground (figure 16).

As to claims 3 and 12, Europe 709 suggests distributing holes over the height of the block.

As to claim 6, the holes suggested by Europe 709 are parallel to the running surface of the block.

#### **Allowable Subject Matter**

6) **Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

Europe 709 fails to motivate and/or suggest modifying Lopez so as to provide a tread in which "the lateral holes zigzag from one plane to the other" (emphasis added) in combination with the remaining limitations of claims 1 and 13.

#### **Remarks**

7) Applicant's arguments with respect to claims 1, 3-13 and 15 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the combination of added limitations in claim 1 (incision intersecting the tread surface and opposite ends of holes open onto respective lateral faces and all of said holes are spaced from said at least one incision), note the new ground of rejection using WO 01/60641.

8) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

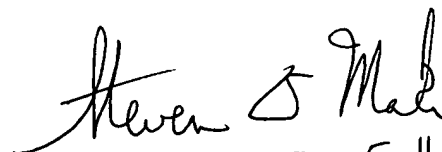
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki  
May 11, 2006

  
STEVEN D. MAKI  
PRIMARY EXAMINER  
5-11-06